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Mailed: MAY 12 2004
In re application of :
Bitler et al. : DECISION ON
Serial No. 09/810,920 : PETITION
Filed: March 16, 2001 :
For: POLYMERIC THICKENERS FOR OIL-CONTAINING COMPOSITIONS

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION mailed October 10, 2003.

On March 21, 2003, a non-final office action was mailed by the examiner, containing multiple grounds of rejection. Applicants responded to this office action with a response filed on June 23, 2003. A final rejection was then mailed on October 10, 2003.

On December 12, 2003, the instant petition under 37 CFR 1.181 was timely filed to formally request the withdrawal of finality of the October 10, 2003 office action.

Applicants position for the withdrawal of the finality is that clear issues have not been developed between the examiner and Applicants, contrary to the guidelines of MPEP 706.07. It is therefore the position of Applicants that the finality of the office action is premature.

DECISION

Section 706.07 of the MPEP states:

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.

In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection.
However, where a single previous Office action contains a complete statement of a ground of rejection, the final rejection may refer to such a statement and also should

include a rebuttal of any arguments raised in the applicant's reply. If appeal is taken in such a case, the examiner's answer should contain a complete statement of the examiner's position.

There are several deficiencies in the final office action of October 10, 2003. The 35 USC 102 rejection will be addressed first. In the non-final office action of March 31, 2003, the examiner changed the basis for the rejection under 35 USC 102 from a rejection over Mueller et al. to a rejection over Mueller et al. with Morawsky et al. as a teaching reference. There is nothing in the body of the rejection other than a statement saying the text of 35 USC 102 can be found in previous office actions. The examiner does not clearly explain why he has brought in a teaching reference and what exactly he is using the reference to teach in conjunction with the primary reference. This information should have been provided to Applicants in the body of the rejection. Likewise, the final rejection only includes a statement that the text of 35 USC 102 can be found in previous office actions. It is noted that the examiner addresses Morawsky in the "response to arguments" section but it is unclear as to whether he is providing support for the 35 USC 102 rejection or the 35 USC 103 rejection. It is also pointed out that in the non-final rejection, claims 1-7, 9-12, 20, 37 and 38 are rejected under 35 USC 102 while in the final rejection, claims 1-5, 9-12, 20, 37-38 and 62-63 are rejected. The examiner should have provided an explanation as to why claims 6 and 7 were not rejected in the final office action or whether they were mistakenly included in the previous grounds of rejection.

Next, the 35 USC 103 rejection will be addressed. In the non-final office action, claims 1-6, 9-12, 20, 37 and 38 were rejected under 35 USC 103 over Mueller et al. in view of Morawsky et al. Once again, the examiner has not included the text of any rejection in the office action, but rather refers to previous office actions. A first office action prepared by the examiner on January 28, 2002 contained a rejection under 35 USC over Mueller et al. This office action contained a 4 line explanation as to why the claims would have been obvious over this single reference. No specific differences were pointed out and a thorough explanation of the rejection was not provided. All of the office actions after this original office action merely referred back to the aforementioned single reference 35 USC 103 rejection. No further explanation was ever given. In the non-final action of March 31, 2003, the examiner changed the 35 USC 103 rejection to a combination rejection over Mueller et al. in view of Morawsky et al. No explanation was provided other than to tell applicants that the text of 35 USC 103 can be found in a previous office action. This rejection was clearly incomplete. All rejections under 35 USC 103 must be evaluated using the *Graham v. Deere* analysis clearly stating what the references teach; any differences between the references and the instant claims; and why said differences would be obvious to one of ordinary skill in the art. The examiner failed to clearly set forth this analysis in the non-final office action of March 31, 2003. The rejection is merely repeated in the final office action with no further explanation as to what the basis for obviousness is.

Further making the record unclear is the fact that all of the claims have been rejected under 35 USC 102 and 35 USC 103 using the same references. If all the claim limitations are met by Mueller et al. as is alleged by the examiner in the 35 USC 102 rejection, then it is unclear as to how a 35 USC 103 rejection over the combination of the same references is applicable. Once again, the examiner has not provided any explanation as to why both a 35 USC 102 and a 35 USC 103 rejection are necessary.

Petitioner has also raised the argument that the examiner has not addressed several arguments presented throughout the prosecution. One such argument that the examiner has made an improper

combination of the two references is a result of the examiner not presenting a complete rejection. This has not given applicants a fair opportunity to respond to the rejections. Petitioner's argument that the instant application is not ready for appeal is persuasive.

Because several issues remain unclear and confusing (e.g. basis of the rejection), this application is being forwarded to the examiner in order to prepare a new non-final office action. All amendments filed up to this point shall be entered. The office action should include all rejections that are being relied upon including a detailed explanation as to how each reference is being applied and how each reference meets each and every claim limitation. Any 35 USC 103 rejection should include a complete *Graham v. Deere* analysis as discussed above. Differences should be clearly pointed out and motivation for any combination should be clearly stated so that applicants have a fair chance to respond. Furthermore, if claims are to be rejected under multiple statutes (i.e. 35 USC 102 and 35 USC 103) the examiner should provide reasoning as to why the claims are being rejected under both. Accordingly, the petition for withdrawal of finality is **GRANTED.**

Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

SHELDON & MAK, INC
225 SOUTH LAKE AVENUE
9TH FLOOR
PASADENA CA 91101